

REMARKS

1. In response to the Office Action mailed March 17, 2008, Applicants respectfully request reconsideration. Claims 1, 3, 5-8, 10-12, 14-17, 21-28, 32, 33, 38, 39, 43-45, 47, 48, 54 and 61-68 were last presented for examination. In the outstanding Office Action, claims 1, 3, 5-8, 10-12 and 14-17 have been rejected, and claims 21-28, 32, 33, 38, 39, 43-45, 47, 48, 54 and 61-63 were previously withdrawn. By the foregoing amendments, claim 6 has been amended, claims 21-28, 32, 33, 38, 39, 43-45, 47, 48, 54 and 61-63 have been canceled and no claims have been added. Thus, upon entry of this paper, claims 1, 3, 5-8, 10-12, 14-17 and 68 will remain pending in this application. Of these fourteen (14) claims, one (1) claim (claim 1) is independent.

2. Based on the above Amendments and following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

Claim Rejections Under 35 U.S.C. §112, First Paragraph

3. The Examiner has rejected claims 6-8 and 68 under 35 U.S. C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that the above claims contain subject matter which was not described in the specification and/or drawings in such a way as to enable one skilled in the art to make and/or use the invention. (*See*, Office Action, pg. 2.) However, the Examiner has not provided any further explanation as to what subject matter in the above claims is not described in the specification/or drawings.

4. As set out in the Manual of Patent Examining Procedure (MPEP), “[i]n order to make a rejection [based on lack of enablement], the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.” (*See*, MPEP §2164.04 citing *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).) In other words, the Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure. (*See, In re Wright*, 999 F.2d 1562.)

5. Applicants respectfully remind the Examiner that a specification which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in the claims must be taken as being in compliance with the enablement requirement, unless “there is a reason to doubt the objective truth of the statements contained therein which must

be relied on for enabling support.” (See, MPEP §2164.04, emphasis added.) Thus, a rejection for failure to teach how to make and/or use is only proper if sufficient reasons to doubt the objective truth of the statements exists. (See, MPEP §2164.04, citing *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The court in *Marzocchi* made it clear that “it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.” Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.” (See, MPEP §2164.04, citing *Marzocchi* 439 F.2d at 224, 169 USPQ at 370; emphasis added.

6. Applicants respectfully submit that the Examiner has not complied with the above obligations in making the outstanding rejections of claims 6-8 and 68 under 35 U.S.C. §112, first paragraph. Specifically, not only has the Examiner failed to identify what elements of the above claims the Examiner believes are not supported by the specification/drawings, but the Examiner has further failed to provide any reasoning or evidence to justify the finding of uncertainty of enablement. Without the explanation required by the MPEP, Applicants lack the ability to meaningfully respond to the Examiner’s rejections and to advance prosecution to a conclusion, or at least to obtain a clear understanding of the difference opinion between Applicants and the Examiner prior to appeal. Therefore, Applicants request that the Examiner issue a new final Office Action in which the Examiner complies with the MPEP and provides the required reasoning and evidence for finding of non-enablement.

Claim Rejections Under 35 U.S.C. §112, Second Paragraph

7. The Examiner has rejected claims 6-8 and 68 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. First, the Examiner rejects claim 6 due to the use of “to be mounted on one or more of the chassis and wall.” (See, Office Action, pg. 3.) The Examiner asserts that the use of “one or more” is not a positive limitation, and “that it is not known as to how many chassis are there.” (See, Office Action, pg. 3.) Although unclear, it appears that the Examiner believes that Applicants are claiming “first and second portions each configured to be mounted” one or more chassis. Applicants respectfully assert that the Examiner’s understanding of

claim 6 is incorrect, because Applicants claimed “first and second portions each configured to be mounted on one or more” of a chassis and wall. Furthermore, Applicants assert that the use of “one or more” in claim 6 is a permissible positive limitation. However, to facilitate prosecution, Applicants have amended claim 6 to make it clear that the “first and second portions each configured to be mounted on one of either a chassis and wall of a housing of an implantable component.” (See, Applicants’ claim 6, above; emphasis added.)

8. Second, the Examiner has objected to claim 6 because “the chassis” lacks proper antecedent basis. (See, Office Action, pg. 3.) Applicants have amended claim 6 to recite “a chassis.” (See, Applicants’ claim 6, above.) Third, the Examiner has objected to claim 6 because the limitation “if an implantable component” is not understood. (See, Office Action, pg. 3.) Applicants thank the Examiner for identifying this typographical error. Applicants have amended claim 6 to recite “of an implantable component.” (See, Applicants’ claim 6, above.)

9. In view of the above amendments, Applicants respectfully request that the rejections of claim 6 under 35 U.S.C. §112, second paragraph, be reconsidered, and that they be withdrawn.

Drawings

10. The Examiner has objected to the drawings under 37 C.F.R. 1.83(a) for allegedly failing to show every feature of the invention specified in the claims. (See, Office Action, pg. 3.) In the Office Action, the Examiner states that “the claimed subject matter i.e., ‘first and second portions each configured to be mounted on one or more of the chassis and wall of a housing [of] an implant component, a first portion and a second portion, and that as in claims 7-8 and 65” are no shown in the drawings.

11. Applicants respectfully remind the Examiner that the MPEP requires the Examiner to provide a full explanation as to how the drawings are incomplete. (See, MPEP §608.02(d), Examiner Note.) Applicants submit that the above confusing statement by the Examiner is not a “full explanation” as to how the drawings are incomplete. Specifically, the Examiner has merely copied Applicants’ claim 6 as well as listed elements of claims 7 and 8, and does not identify which of the listed features from claims 6-8 are missing from the drawings. Without the explanation required by the MPEP, Applicants lack the ability to amend the drawings and/or meaningfully respond to the Examiner’s objections to advance prosecution. Therefore, Applicants

request that the Examiner issue a new final Office Action in which the Examiner complies with the MPEP and provides the required “full explanation” as to how the drawings are incomplete.

12. As noted, without the MPEP required full explanation, Applicants cannot determine what features the Examiner believes need to be added to the drawings. However, Applicants submit that the features of claims 6-8 are shown in the drawings, including a housing 14 having a chassis and wall, a feedthrough member 11 comprising a first portion 15 and a second portion 16, and a wire 18. Therefore, Applicants submit that the Examiner’s objections to the drawings are improper, and should be withdrawn.

Claim Rejections Under 35 U.S.C. §102

13. The Examiner has rejected claims 1, 5 and 10-12 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,824,306 to Pfaff, (hereinafter, “Pfaff”). Applicants respectfully disagree.

14. Pfaff is directed to a large scale loop antenna for use in a radio receiver of a building or portable radio. (See, Pfaff, col. 1, lns. 1-32.) Such loop antennas “usually consist of a number of turns of wire, usually wound in close proximity to each other.” (See, Pfaff, col. 1, lns. 35-38.) These loops of wire may be wound around, for example, the outside of a cabinet or are supported on a fiber insulating form secured to a cabinet. (See, Pfaff, col. 1, lns. 35-38.)

15. The loop antenna of Pfaff is an improvement over prior art antennas because the described antenna has an increased factor of merit, referred to as the antenna’s Q. (See, Pfaff, col. 2, lns. 11-63.) The Q of an antenna is directly proportional to the ability of the antenna to “pick up desired signals.” (See, Pfaff, col. 1, lns. 46-70.) Therefore, by increasing the Q, the antenna of Pfaff is designed to have a reception that is superior to then-prior art devices. (See, Pfaff, col. 1, lns. 46-70.) The Q of the loop antenna is increased by changing the permeability of the material separating the coils of the loop. (See, Pfaff, col. 2, lns. 11-63.)

16. As shown in FIG. 3 of Pfaff, the wire of the antenna is wound around a Bakelite tube. The Bakelite tube is then placed around an iron rod having a permeability that is much higher than the permeability of air, thereby increasing the Q factor of the antenna. (See, Pfaff, Figure 3; col. 4, lns. 15-42.) The iron rod and tubing are then secured to a cover plate via brackets. (See, Pfaff, Figure 3; col. 4, lns. 15-42.) The ends of the wire are attached to a trimmer condenser mounted to the

cover plate. (*See*, Pfaff, Figure 3; col. 5, lns. 3-9.)

Claim 1

17. Applicants' claim 1 is directed to a "method of forming an antenna configured to be implanted in a recipient, comprising: positioning a feedthrough member relative to an antenna template." (*See*, Applicants' claim 1, above.) In response to the non-final Office Action mailed March 17, 2008, Applicants submitted arguments demonstrating that Pfaff fails to disclose a "feedthrough member," and thus cannot disclose "positioning a feedthrough member relative to an antenna template" as recited in Applicants' claim 1. (*See*, Applicants' prior response filed July 17, 2008, pgs. 11-13, hereinafter referred to as Applicants' prior response.) In the outstanding Office Action, the Examiner continues to assert that the trimmer condenser of Pfaff is equivalent to a "feedthrough member" as recited in Applicants' claim 1. (*See*, Office Action, pg. 6.) Specifically, the Examiner asserts that in Pfaff, "the wires 30/31 are connected to a feed through connector which is a part of" the trimmer condenser 37. (*See*, Office Action, pg. 6.) The Examiner then asserts because "feedthrough" is broad, the alleged connector of Pfaff is readable on a feedthrough, and that Pfaff discloses the limitations of claim 1. (*See*, Office Action, pg. 6.)

18. It is well known that a trimmer condenser, sometimes referred to as a trimmer capacitor, is a type of variable capacitor that permits one to adjust the performance of a circuit by increasing or decreasing the capacitance of the circuit. As shown in FIG. 3 of Pfaff, the trimmer condenser is directly connected to wires 30 via exposed connectors. (*See*, Pfaff, FIG. 3.) As would be appreciated by one of ordinary skill in the art, in order for the system of Pfaff to operate, the condenser connectors are conductive elements which are brought into physical contact with the wires, thereby providing an electrical connection there between. (*See*, Pfaff, FIG. 3.)

19. Applicants respectfully remind the Examiner that "[i]n the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the **ordinary and customary meanings attributed to them by those of ordinary skill in the art.**" (*See*, MPEP §2111.01, quoting *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) (emphasis added). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." (*See*, MPEP § 2111.01, quoting *Phillips*, 415 F.3d 1303,

1313.) Applicants respectfully assert that the Examiner is reading the claim term “feedthrough” unreasonably broadly. In particular, Applicants assert that one of ordinary skill in the art would not find that a conductive member which is directly electrically connected to a wire to be equivalent to a “feedthrough.”

20. Therefore, because Pfaff does not disclose a “feedthrough,” Applicants assert that it is impossible for Pfaff to anticipate or render obvious “positioning a feedthrough member relative to an antenna template.” (*See*, Applicants’ claim 1, above.) As such, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §102 be reconsidered, and that it be withdrawn.

21. Furthermore, because the Examiner has not provided any sound basis or support to justify the assertion that the connectors of Pfaff are equivalent to a “feedthrough,” it is clear that the Examiner is relying on information within the personal knowledge of the Examiner. Accordingly, Applicants request that the Examiner provide an Affidavit/Declaration under 37 C.F.R. §1.104(d)(2) supporting these statements of fact that are within the personal knowledge of the Examiner and upon which the Examiner has relied on in finding that the connectors of Pfaff equivalent to a “feedthrough.”

22. Furthermore, in Applicants prior response, Applicants argued that even if the trimmer condenser of Pfaff were equivalent to a “feedthrough” (which it is not), Pfaff would still fail to anticipate or render obvious the above elements because the antenna of Pfaff is not “configured to be implanted in a recipient” as recited in Applicants’ claim1. (*See*, Applicants’ prior response, pgs. 11-13.) Specifically, Applicants argued that Pfaff describes a radio antenna designed for large scale applications, such as portable radios. (*See*, Pfaff, col. 1, lns. 1-32.) To this end, the antenna of Pfaff comprises an iron rod surrounded by Bakelite tubing which is secured to a cover plate via brackets. (*See*, Pfaff, Figure 3; col. 4, lns. 15-42.) Thus, Applicants asserted that an antenna comprising an iron rod and attached to a cover plate via brackets is not “configured to be implanted in a recipient” as recited in Applicants’ claim 1. In the outstanding Office Action, the Examiner failed to address these arguments.

23. As stated in the MPEP, an Examiner “must address all arguments which have not already been responded to.” (*See*, MPEP, §707, para. 7.37, Examiner Note.) The Examiner must further provide an explanation as to non-persuasiveness. (*See*, MPEP, §707, para. 7.37, Examiner Note.) Because the Examiner has failed to address Applicants’ argument that Pfaff fails to disclose an

antenna “configured to be implanted in a recipient,” Applicants assert that the Examiner has failed to comply with the requirements of the MPEP. Without an explanation to non-persuasiveness, Applicants lack the ability to meaningfully respond to the Examiner and to advance prosecution to a conclusion, or at least to obtain a clear understanding of the difference opinion between Applicants and the Examiner prior to appeal. (*See*, MPEP, §706.07.) Therefore, Applicants request that the Examiner issue a new final Office Action in which the Examiner complies with the MPEP and addresses all of Applicants’ arguments.

24. For at least the reasons discussed above, Applicants assert that Pfaff fails to anticipate or render obvious all elements of Applicants’ claim 1. Applicants further assert that the other art of record also fail to teach or suggest that which is missing from Pfaff. Therefore, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §102 be reconsidered, and that it be withdrawn.

Claim Rejections Under 35 U.S.C. §103

25. The Examiner has rejected claims 3 and 14-16 under 35 U.S.C. 103(a) as being unpatentable over Pfaff. Similarly, claim 17 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Pfaff in view of U.S. Patent No. 5,779,839 to Tuttle *et al.*, (hereinafter, “Tuttle”). Without addressing the apparent impropriety of the proposed modifications to Pfaff, Applicants respectfully assert that, for at least the reasons discussed above with reference to claim 1, the rejections under 35 U.S.C. §103 are improper. In particular, Applicants assert that Pfaff fails to teach that which is asserted by the Examiner, and that Tuttle fails to teach that which is missing from Pfaff. As such, Applicants respectfully submit that the rejections under 35 U.S.C. §103 are improper and should be withdrawn.

Cancellation of Claims

26. In the outstanding Office Action, the Examiner stated because the application contains claims drawn to a non-elected invention, a “complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action.” (*See*, Office Action, pg. 6.) Applicants respectfully remind the Examiner that withdrawal of non-elected claims is an appropriate action to constitute a complete reply. In Applicants’ prior response, all claims directed to non-elected subject matter were withdrawn.

27. To facilitate prosecution of this application, Applicants have, by the above claim amendments, cancelled all claims directed to non-elected subject matter. Cancellation of these claims should not be construed as an admission to the validity of the Examiner's above statement. Furthermore, Applicants do not intend to dedicate non-elected claims to the public and reserve the right to file divisional applications for the subject matter covered by the non-elected claims.

Dependent Claims

28. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicants respectfully assert that the dependent claims are also allowable over the art of record.

Conclusion

29. In view of the foregoing, Applicants respectfully submit that this application is now in condition for allowance. A notice to this effect is respectfully requested.

30. Applicants make no admissions by not addressing any outstanding rejections or basis of rejections. Furthermore, Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Thus, cancellations and amendments of above claims should not to be construed as an admission regarding the patentability of any claims.

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Respectfully submitted,

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